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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,413	04/20/2000	Dominique Briere	11496-195086	5942
826	7590	10/10/2003	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			DAVIS, ROBERT B	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,413

Applicant(s)

BRIERE ET AL.

Examiner

Robert B. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 34-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/945,089.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Reissue Applications

1. The objection to the specification has been withdrawn in response to Applicant's amendment to the specification.

2. Claims 15-21 and 34-40 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Original claim 1 of the patent included the following limitations.

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a

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half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

The claim was amended to recite the following:

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures and which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

Claims 15, 35, 36 and 39 of the reissue application have the limitation "said shell holders being shaped to be supported by two mold carriers made in the form of

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enveloping structures". However, applicant argues that the two mold carriers are not a structural element of the claim.

Hence, these claims are broader than the patent claim 1. Further, the subject matter of original claim 1 was amended to overcome an art rejection. Applicant added to the limitation of "two mold carriers" the following phrase "which are made in the form of enveloping structures". On page 6 amendment filed September 28, 1998, applicant argues that "Appel does not teach or suggest a device with mold carriers which sound (typo for surround) respective shell holders. Moreover, even if one imagines that elements 43, 44 in Appel are shell holders, that elements, 130, 131 are shells and that elements (axis and arms 118-121) are mold carriers, such an argument would be erroneous from a structural point of view. This is true for at least the reason that the above-mentioned elements are obviously pivot elements corresponding to axis 4 of the present invention. Moreover, even assuming arguendo that rods 118-119 are mold carriers, said rods are surely not surrounding elements, and they cannot provide rigidity, contrary to standard mold-carriers." It is clear that the mold-carriers are positive structural elements of claim 1 of the patent. It is further clear that the limitation of the mold carriers was amended and argued by applicant to overcome a prior art rejection. The present claims 15, 35, 36 and 39 have been amended to further define the structure of the "at least one quick-fixing locking member", but the absence of the mold carriers being in the shape of enveloping structures from these claims constitutes recapture as this limitation was amended and argued to overcome a prior art rejection. See *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997).

3. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 15, 35, 36 and 39 have been amended in the amendment filed May 30, 2003. The change equates to an error, which was not covered by a prior declaration.

Claims 1-21 and 34-40 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Response to Arguments

4. Applicant's arguments filed May 30, 2003 have been fully considered but they are not persuasive.

Applicant recites the MPEP section 1412.02 directed to the subject matter "Reissue for Article Claims Which are Functional Descriptive Material Stored on a Computer-Readable Medium". The MPEP does not provide general guidance for introduction of any different statutory category beyond the fact specific example of an article claim having descriptive material stored on a computer-readable medium. The present claims 15-21 and 34-40 are directed to a subcombination in relation to the

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combination of claim 1 of the Patent 5,968,560. Thus, the subcombination and combination are not different statutory categories of invention.

Applicant further discusses In re Clement and the recapture test. In regards to the recapture test, it is clear that the surrendered subject matter relates to the limitation, "respectively supported by two mold carriers in the form of enveloping structures movable and which can move one with respect to the other". The position of the examiner is that any claim which claims "respectively supported by two mold carriers which can move one with respect to the other" or less is barred by recapture.

Applicants have taken the position that the "two mold carriers" are not positive elements of claims 15, 35, 36 and 39. Thus, these claims clearly fail the recapture test as the further narrowing of the limitation "quick-fixing means" does not relate to the surrendered subject matter of the "two mold carriers". The argument that applicant has not surrendered the ability to claim the invention via a different statutory category of invention is not convincing as a combination/subcombination comparison of present claims 15, 35, 36 and 39 and claim 1 of Patent 5,968,560 does not result in the subcombination being a different statutory category of invention in relation to the combination. The argument that further limiting the shell holders in respect of the shape to be supported by the mold carriers is a result of shifting statutory claim categories is not convincing. The shift from the manufacturing device to the mold assembly is recapture because the eliminated limitation of the "two mold carriers" is the surrendered limitation to overcome a prior art rejection.

Applicant is directed to *Pannu v. Storz Instruments Inc.*, 59 USPQ2d 1597 (CAFC 2001), which provides guidance to the question of whether a claim that is broader in one respect and narrower in another avoids recapture. In the aforementioned case, applicant limited the haptic's dimensions and positioning, while eliminating the shape of the haptics. Thus, the broadened aspect of eliminating the shape of the haptics was determined by the court to be recapture as the shape of the haptics was surrendered subject matter. The limiting of the haptic's dimensions and positioning did not overcome the recapture because these limitations were not directly pertinent to the specific aspect that was narrowed during prosecution, shape of haptics.

5. The rejection of claims 1-14 can be overcome by filing a supplemental declaration or by cancellation of claims 15-21 and 34-40.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

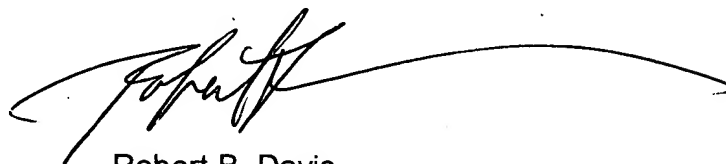
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Davis whose telephone number is 703-308-2625. The examiner can normally be reached on Monday-Friday 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Robert B. Davis
Primary Examiner
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8/7/03

August 7, 2003